

REMARKS

The Office Action dated November 4, 2004 has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto. No new matter has been added. Claims 1-34 are pending in the above-cited application and are resubmitted for consideration.

Claims 3, 8, 9, 10, 11, 12, 17, 18, 20 and 30 were rejected under 35 USC § 112, second paragraph, as being indefinite. Specifically, the Office Action alleged that the phrase "in a suitable information element" recited in claims 3 and 20 is too broad because this phrase may encompass a broad range of materials and/or equipment used for information transmission. Therefore, this phrase allegedly rendered claims 3 and 20 indefinite. Applicants have amended those claims to address this rejection and now respectfully assert that the claims are now definite under 35 USC § 112, second paragraph. Reconsideration and withdrawal of the rejection are respectfully requested.

The Office Action rejected claims 1, 3, 18 and 20 under 35 U.S.C. § 102(b) as being anticipated by *Gore et al.* (U.S. Patent No. 5,313,463). The Office Action also rejected claims 2, 4, 19 and 21 under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Wrede et al.* (U.S. Patent No. 5,937,040). Claims 5 and 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of the *European Telecommunication Standards Institute Reference (February 1996)*. Claims 6 and 23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of the *European Telecommunication Standards Institute Reference (October 1991)*. Claims

7 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Newton's Telecom Dictionary* (March 1998). Claims 8-11, 13-16, 25-28 and 30-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Boivie* (U.S. Patent No. 4,633,041). Claims 12, 17, 29 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gore et al.* in view of *Boivie* and further in view of *Masuda* (U.S. Patent No. 4,709,387). The above rejections, as might be applied against the presently amended claims, are respectfully traversed.

The present invention is directed, according to claim 1, to a method for providing telephone book information in a digital multiple-service network. The network includes an exchange, a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first interface, and a called subscriber telecommunication terminal connected to the network via a second interface. The method includes requesting calling subscriber telephone book information by sending from the called subscriber telecommunication terminal to the exchange a message requesting the calling subscriber telephone book information and comprising the number of the calling subscriber, the request being initiated by the called subscriber, in response to the received message, sending a query for the calling subscriber telephone book information from the exchange to a server implementing a telephone book information service, the server being connected to the multiple-service network via a third interface, in response to the received query, sending the calling subscriber telephone book information from the server to the exchange and in response to the received calling subscriber telephone book

information, sending the calling subscriber telephone book information from the exchange to the called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of information not belonging to the call.

The present invention is also directed, according to claim 18, to a system for providing telephone book information in a digital multiple-service network. The network includes an exchange, a calling subscriber telecommunication terminal connected to the digital multiple-service network via a first interface, and a called subscriber telecommunication terminal connected to the network via a second interface. The system includes requesting means for requesting calling subscriber telephone book information by sending, from the called subscriber telecommunication terminal to the exchange, a message requesting the calling subscriber telephone book information and comprising the number of a calling subscriber, the request being initiated by the called subscriber, first sending means for sending a query for the calling subscriber telephone book information from the exchange to a server implementing a telephone book information service, the server being connected to the multiple-service network via a third interface, in response to the received message, second sending means for sending the calling subscriber telephone book information from the server to the exchange, in response to the received query and third sending means for sending the calling subscriber telephone book information from the exchange to the called subscriber telecommunication terminal using channels reserved for signaling and a signaling protocol comprising a limited amount of

information not belonging to the call, in response to the received calling subscriber telephone book information.

Gore et al. is directed to process of credit checking in an ISDN environment. The credit check is implemented using a credit-checking database. Credit-check information is transmitted to the ISDN terminal using a D-channel and the results from the credit-checking database is passed back through the network to the sending business. The office makes several assertions of equivalence in the rejections applying *Gore et al.*

A central aspect of the present invention is a service that is provided for a called subscriber. To elaborate, the present invention seeks to provide telephone book information of a calling subscriber to the called subscriber either while a call is being made (i.e., before the called subscriber answers the call) or after the call. The present invention is concerned with a service provided for a called subscriber and it is the called subscriber that launches the process by requesting a service. Claim 1 recites “requesting calling subscriber telephone book information by sending from the called subscriber telecommunication terminal to the exchange a message requesting the calling subscriber telephone book information” and claim 18 “requesting means for requesting calling subscriber telephone book information by sending, from the called subscriber telecommunication terminal to the exchange, a message requesting the calling subscriber telephone book information.” The cited references do not teach or suggest a service process initiated by a called subscriber.

The cited references do not teach or suggest providing such a service for a called

subscriber. In particular, the combination of *Gore et al.* and *Boivie* fails to teach or suggest a telephone book information service that is provided for and initiated by a called subscriber. [The combination of further fails to teach or suggest a telephone book information service that the called subscriber can use during a call. The combination also fails to teach or suggest a telephone book information service that can be implemented on an ISDN-network. As such, Applicants respectfully request that the prior art rejections be reconsidered and withdrawn.]

The above-discussed deficiencies are also not cured by the addition of *Wrede et al.*, *European Telecommunication Standards Institute Reference* (February 1996), *European Telecommunication Standards Institute Reference* (October 1991), *Newton's Telecom Dictionary* (March 1998), *Boivie* and *Masuda*, in the other rejections. Even if these references were accepted to disclose what the Office has alleged, which Applicants do not admit, they do not teach or suggest the elements not taught by *Gore et al.*, as discussed above. Similarly, claims 2-7, 10-12, 16, 19-24, 27-29 and 33, which depend from claims 1 and 18, should be allowed for at least their dependence on those independent claims.

To conclude, Applicants respectfully request the allowance of claims 1-7, 10-12, 16, 18-24, 27-29 and 33, and request that the application be allowed to pass to issue. If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the

applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



Kevin F. Turner
Registration No. 43,437

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Tysons Corner, Virginia 22182-2700
Telephone: 703-720-7800
Fax: 703-720-7802

KFT:lls